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EXAMINER

WONG, LESLIE

ART UNIT	PAPER NUMBER
2177	13

DATE MAILED: 07/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/728,783

Applicant(s)

PINGEL ET AL.

Examiner

Leslie Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 19 April 2004 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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3. Claims 1-4, 6-18, and 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mielenhausen** (U.S. Patent 6,529,911 B1) in view of **Amro et al.** ("**Amro**") (U.S. Patent 5,867,678).

Regarding claim 1, **Mielenhausen** teaches a method of creating a reference database for a computer-readable document comprising:

a). '**entering user inputted text data for said computer-readable document in a data file**' as through the Legal Research Organizer (LRO)'s Transfer Project Data Window, all data tied to the project description highlight in the Projects Window can be transferred to or from another LRO program via floppy disk or modem. Thus, the user's project data can be placed in a data file to be loaded on to a floppy disk to transfer to another project (col. 5, lines 55-59 and lines 48-54);

b). '**determining whether a user inputted a request to input reference data**' as when the user navigate to the LRO's Transfer Project Data Window, it is apparent that the user attempts to input the project data into a file and transfer it to another LRO program (col. 5, lines 27-28; col. 6, line 25 and line 40);

c). '**entering user inputted reference data into the reference database following said determining finding said user inputted said request to input reference data**' as the user can add one or more citations to the Research Database search Results window and LRO automatically saves data when user closes a window (col. 8, lines 1-10; col. 5, lines 29-36; col. 17, lines 40-44); and

d). **'wherein said other data includes at least one citation to said user inputted reference data'** as through the LRO's Past/View Research Database Cite List Window, the user can past a list of citations, downloaded from the CD-ROM or on-line research database. The user can then add one or more of those citations to the Research Database Search Results Window, along with data showing the status of users' review of each citation. Further, LRO automatically saves data when user closes a window (col. 7, lines 52-65; col. 8, lines 1-10; col. 2, lines 18-35; col. 17, lines 40-44).

Mielenhausen does not explicitly teach storing the reference database, said user inputted text data, and other data of the computer-readable document in said data file.

Amro, however, teaches **'storing the reference database, said user inputted text data, and other data of the computer-readable document in said data file'** as a compound document contains multiple objects capable of running within the document, such as a spreadsheet (i.e., database), text, and hotlinks etc...(col. 4, lines 4-7 and Fig. 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Amro's** teaching would have allowed **Mielenhausen's** to ensure that all reference related data is available for access by binding separate documents together can create a well organized, coherent collection of information as suggested by Kanerva at col. 1, lines 15-18.

Regarding claims 2, 13, 16, and 23, **Mielenhausen** further teaches wherein the computer readable document further comprises **'a reference field for retrieving a record stored in the reference database'** as the user can view, add, and edit descriptions of the research projects tied to the user's or network's LRO license number. Each description includes the project number (e.g., 98-100532), project name, the client name and number etc... (col. 5, lines 31-36).

Regarding claims 3, 14, and 17, **Mielenhausen** further teaches wherein the reference database further comprises:

- a). **'fields for different types of reference data sources'** as the LRO's Research Database Search Results Window contains word search field, Research database field, and Jurisdictions searched field (Fig. 11); and
- b). **'fields containing specific information associated with these different types of reference data sources'** as the Cite List Window indicates the data each list relating to the database was pasted (col. 8, lines 5-9 and Fig. 15).

Regarding claims 4 and 18, **Mielenhausen** further teaches wherein **'the reference database comprises a bibliographic database, and the reference data sources comprise books, journals, conference presentations, web-pages and e-mails'** as for each proposition researched, the user can create, edit, and view a record of each search conducted in each database or other resource, including a search of the data processing itself for related data in other projects previously entered by the user or

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others in the user's organization. Examples of the reference sources used by the prior art are books, journal, websites, online databases, and CD-ROM databases (col. 3, lines 18-28; col. 1, lines 58-63; col. 11, lines 9-11).

Regarding claim 8, **Mielenhausen** further teaches wherein said **'method is stored as computer code in a storage medium'** as a data processing method for organizing, analyzing recording, *storing*, and reporting research results. It should be apparent to the reader that in a data processing environment, data such as program code and other related data are processed by the computer and stored in a storage device such as hard disks, tape, optical discs, and/or floppy disks for latter retrieval for stored information (col. 2, lines 18-20).

Regarding claim 9, **Mielenhausen** further teaches wherein said **'computer code is downloaded into said storage medium'** as through the LRO's Paste/View Word Processor Documents List Window, the user can paste a list of document descriptions, downloaded from the user's word processing program. The user can then add one or more of those descriptions to the Word Processor Documents Search Results Window. Further, LRO automatically saves data when user closes a window (col. 8, lines 56-65; col. 7, lines 52-65).

Regarding claims 6 and 20, **Mielenhausen** further teaches a step of **'displaying a user interactive dialogue window for inputting reference data'** as through the

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LRO's Basic Information on Authority Window, the user can edit the citation to the authority highlighted in the Authorities Window. The user can also, view, add, and edit relevant, non-analytical information regarding the authority, including the date of the authority, the jurisdictions and choices of law to which the authority pertains, and the type of authority (col. 10, lines 13-23; Fig. 14; and Figs. 4A-4E).

Regarding claims 7, 21, and 24, **Mielenhausen** further teaches a step of **'synchronizing the reference database with other data sources'** as cases, statutes, legislative history, articles and other authorities can now be found at numerous web sites on the Internet, including web sites maintained by state and federal appellate courts and governmental agencies. After performing the word search, via a web site, the user can enter, organize, and analyze the results in LRO. Through LRO's Web Sites Search Results Window, the user can view, add, edit, and delete citations obtained from the web site (col. 8, line 67 – col. 9, line 16; col. 10, lines 59-67; col. 11, lines 9-28).

Regarding claim 10, **Mielenhausen** teaches an apparatus comprising:

'a processor' as a data processing system for legal research projects (col. 1, lines 66-67). It should be apparent to the reader that **Mielenhausen** teaches the storing and processing data on a computer and that all computers must have processors to execute computer program instructions; and

'a storage medium coupled to said processor' as the user can create, edit, and view a record of each search conducted in each database (col. 3, lines 18-25), and

'wherein said computer-readable document includes at least one citation to information in said reference database' as through the LRO's Past/View Research Database Cite List Window, the user can past a list of citations, downloaded from the CD-ROM or on-line research database. The user can then add one or more of those citations to the Research Database Search Results Window, along with data showing the status of users' review of each citation. Further, LRO automatically saves data when user closes a window (col. 7, lines 52-65; col. 8, lines 1-10; col. 2, lines 18-35; col. 17, lines 40-44).

Mielenhausen does not explicitly teach a reference database for a computer-readable document, storing user inputted reference data, together with a said computer-readable document including user inputted text data in a single data file.

Amro, however, teaches **'a reference database for a computer-readable document, storing user inputted reference data, together with a said computer-readable document including user inputted text data in a single data file'** as a compound document contains multiple objects capable of running within the document, such as a spreadsheet (i.e., database), text, and hotlinks etc... (col. 4, lines 4-7 and Fig. 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Amro's**

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teaching would have allowed **Mielenhausen's** to ensure that all reference related data is available for access by binding separate documents together can create a well organized, coherent collection of information as suggested by Kanerva at col. 1, lines 15-18.

Regarding claim 11, **Mielenhausen** further teaches wherein said **'processor is in a first device, and said storage medium is in a second device'** as online databases contains the processor which resides on a first device versus the storage medium of LRO on a second device (col. 7, lines 34-41).

Regarding claim 12, **Mielenhausen** teaches **'wherein said other data includes at least one citation to said user inputted reference data'** as through the LRO's Past/View Research Database Cite List Window, the user can past a list of citations, downloaded from the CD-ROM or on-line research database. The user can then add one or more of those citations to the Research Database Search Results Window, along with data showing the status of users' review of each citation. Further, LRO automatically saves data when user closes a window (col. 7, lines 52-65; col. 8, lines 1-10; col. 2, lines 18-35; col. 17, lines 40-44).

Mielenhausen does not explicitly teach a storage medium having stored thereon in a single data file a computer-readable document comprising a reference database storing user inputted reference data, user inputted text data and other data of the computer-readable document.

Amro, however, teaches **'a storage medium having stored thereon in a single data file a computer-readable document comprising a database storing user inputted data, user inputted text data and other data of the computer-readable document'** as a compound document contains multiple objects capable of running within the document, such as a spreadsheet (i.e., database), text, and hotlinks etc... (col. 4, lines 4-7 and Fig. 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Amro's** teaching would have allowed **Mielenhausen's** to ensure that all reference related data is available for access by binding separate documents together can create a well organized, coherent collection of information as suggested by Kanerva at col. 1, lines 15-18.

Regarding claim 15, **Mielenhausen** teaches a computer program for creating a reference database for a computer-readable document, the computer program comprising program code adapted for:

a). **'entering user inputted text data for said computer-readable document in a data file'** as through the Legal Research Organizer (LRO)'s Transfer Project Data Window, all data tied to the project description highlight in the Projects Window can be transferred to or from another LRO program via floppy disk or modem. Thus, the user's project data can be placed in a data file to be loaded on to a floppy disk to transfer to another project (col. 5, lines 55-59 and lines 48-54);

b). **'determining whether a user inputted a request to input reference data'** as when the user navigate to the LRO's Transfer Project Data Window, it is apparent that the user attempts to input the project data into a file and transfer it to another LRO program (col. 5, lines 27-28; col. 6, line 25 and line 40);

c). **'entering user inputted reference data into the reference database following said determining finding said user inputted said request to input reference data'** as the user can add one or more citations to the Research Database search Results window and LRO automatically saves data when user closes a window (col. 8, lines 1-10; col. 5, lines 29-36; col. 17, lines 40-44); and

d). **'wherein said other data includes at least one citation to said user inputted reference data'** as through the LRO's Past/View Research Database Cite List Window, the user can past a list of citations, downloaded from the CD-ROM or on-line research database. The user can then add one or more of those citations to the Research Database Search Results Window, along with data showing the status of users' review of each citation. Further, LRO automatically saves data when user closes a window (col. 7, lines 52-65; col. 8, lines 1-10; col. 2, lines 18-35; col. 17, lines 40-44).

Mielenhausen does not explicitly teach storing the reference database, said user inputted text data, and other data of the computer-readable document in said data file.

Amro, however, teaches **'storing the database, said user inputted text data, and other data of the computer-readable document in said data file'** as a compound document contains multiple objects capable of running within the document, such as a spreadsheet (i.e., database), text, and hotlinks etc... (col. 4, lines 4-7 and Fig. 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Amro's** teaching would have allowed **Mielenhausen's** to ensure that all reference related data is available for access by binding separate documents together can create a well organized, coherent collection of information as suggested by Kanerva at col. 1, lines 15-18.

Regarding claim 12, **Mielenhausen** teaches a computer program product for creating a reference database for a computer-readable document, the computer program product comprising program code adapted for:

a). **'entering user inputted text data for said computer-readable document in a data file'** as through the Legal Research Organizer (LRO)'s Transfer Project Data Window, all data tied to the project description highlight in the Projects Window can be transferred to or from another LRO program via floppy disk or modem. Thus, the user's project data can be placed in a data file to be loaded on to a floppy disk to transfer to another project (col. 5, lines 55-59 and lines 48-54);

b). **'determining whether a user inputted a request to input reference data'** as when the user navigate to the LRO's Transfer Project Data Window, it is apparent that the user attempts to input the project data into a file and transfer it to another LRO program (col. 5, lines 27-28; col. 6, line 25 and line 40);

c). **'entering user inputted reference data into the reference database following said determining finding said user inputted said request to input reference data'** as the user can add one or more citations to the Research Database search Results window and LRO automatically saves data when user closes a window (col. 8, lines 1-10; col. 5, lines 29-36; col. 17, lines 40-44); and

d). **'wherein said other data includes at least one citation to said user inputted reference data'** as through the LRO's Past/View Research Database Cite List Window, the user can past a list of citations, downloaded from the CD-ROM or on-line research database. The user can then add one or more of those citations to the Research Database Search Results Window, along with data showing the status of users' review of each citation. Further, LRO automatically saves data when user closes a window (col. 7, lines 52-65; col. 8, lines 1-10; col. 2, lines 18-35; col. 17, lines 40-44).

Mielenhausen does not explicitly teach storing the reference database, said user inputted text data, and other data of the computer-readable document in said data file.

Amro, however, teaches **'storing the database, said user inputted text data, and other data of the computer-readable document in said data file'** as a

compound document contains multiple objects capable of running within the document, such as a spreadsheet (i.e., database), text, and hotlinks etc... (col. 4, lines 4-7 and Fig. 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Amro's** teaching would have allowed **Mielenhausen's** to ensure that all reference related data is available for access by binding separate documents together can create a well organized, coherent collection of information as suggested by Kanerva at col. 1, lines 15-18.

4. Claims 5 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mielenhausen** (U.S. Patent 6,529,911 B1) in view of **Amro et al.** ("**Amro**") (U.S. Patent 5,867,678) as applied to claims 1-4, 6-18, and 20-24 above and further in view of **Lawrence et al.** ("**Lawrence**") (U.S. Patent 6,289,342 B1).

Regarding claims 5 and 19, **Mielenhausen** and **Amro** teach the subject matters as discussed above.

Mielenhausen and **Amro** do not explicitly teach wherein the reference database further comprises one field containing information about a number of citations of a reference in the document.

Lawrence, however, teaches 'the reference database further comprises one field containing information about a number of citations of a reference in the

document' as storing in Tables 2-4, the number of citations, baseline sample, and word matching etc... for the reference documents for ranking similarity of documents (col. 15, tables 2-4).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Lawrence's** teaching would have allowed **Mielenhausen-Amro's** to provide ranking of papers, journal, authors, etc. by the number of citations via extracting identifies identical citations which occur in different formats, and identifies the context of citations in the body of article. Thus, the prior art facilitates locating related papers/documents which share one or more references to enable measuring the documents similarity by context analysis as suggested by **Lawrence** at col. 18, lines 4-11.

Response to Argument

5. Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Terry et al. US005581753A

Walker et al. US006449616B1

Tada et al. US005832476A

Pitkow et al. US006182091B1

Garfield et al. US006728725B2

Drucker et al. US006505196B2

Lawrence et al. – Indexing and Retrieval of Scientific Literature

House et al. – Trust and Epistemic Communities in Biodiversity Data Sharing

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie Wong whose telephone number is (703) 305-3018. The examiner can normally be reached on Monday to Friday 9:30am - 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Leslie Wong
Patent Examiner

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